

## REMARKS

The specification has been amended just to delete an unnecessary and apparently confusing definition of "alkylene."

The claims have been amended to expedite prosecution. The limitations of claim 4 have been inserted into claim 1 as an alternative definition of Y and the limitations of claim 11 have been added to claim 1 as a definition of L<sup>1</sup>. The limitations set forth on page 7 with regard to adjacent substituents forming a fused ring on Ar have also been added and the limitation on the distance between the atom of Ar linked to L<sup>2</sup> in the center of the  $\alpha$  ring has been deleted from the claims as now unnecessary. No new matter has been added and entry of the amendment is respectfully requested.

### The Rejections Under 35 U.S.C. § 112, Second Paragraph

Claim 1 was rejected under this section on a number of grounds which, it is believed, are addressed adequately by amendment and the following remarks. First, the term "isostere thereof" no longer appears in claim 1; instead, the specific isosteres set forth in claim 4, which was not objected to, have been inserted. Second, "non-interfering substituents" is objected to, but no explanation is given. The nature of "non-interfering substituents" has been set forth on page 5 in detail. It is believed that this term is clear in the context of the present claims, and unless there is some basis for making this rejection, applicants believe the term should remain in the claims.

"Each of W and X is a spacer of 2-6 Å" is also objected to, but again no basis for this rejection is provided. It is believed that this term is clear since W and X are defined as substituted or unsubstituted alkylene, alkenylene or alkynylene and the distance specification simply limits the number of carbons in the chain.

"Ar is an aryl group substituted with 0-5 non-interfering substituents wherein two non-interfering substituents can form a fused ring" is objected to; however, there is no explanation for why this is indefinite or unclear is provided.

Finally, "the distance between the atom of Ar linked to L<sup>2</sup> in the center of the  $\alpha$  ring is 4.5-24 Å" is objected to. This limitation no longer appears in the claims as it appears unnecessary in light of the definitions of L<sup>1</sup> and L<sup>2</sup>. It is believed that the amendment and discussion dispose of the rejections made under this statutory section.

#### The Rejection Under 35 U.S.C. § 112, First Paragraph

Again, only claim 1 was criticized or rejected under this statutory section. The first rejection relates to alleged new matter concerning substituents on adjacent positions of Ar to form a fused ring of 3-8 members. The claim has been amended to conform to the limitations in the specification. Thus, it is believed that this basis for rejection is moot.

The second basis for rejection has to do with the infamous definition of alkylene, as  $-(CH_2)_n-$  on page 3. This definition has been removed by amendment. Such removal is not new matter. The Office continues to insist that the  $n$  in *this context* must be 0-3 because  $n$  in an *entirely different context* (as the number of R<sup>3</sup> substituents in the formula of claim 1) is defined that way. Respectfully, no skilled artisan would ever interpret these two designations of  $n$  to refer to the same thing. It would be recognized that the " $n$ " in the formula  $-(CH_2)_n-$  is a generic designation meaning an undetermined number and totally undefined. It is believed that this basis for rejection is inappropriate.

Applicants have already explained the origin of the limitation (1-4C) in previous responses but to repeat, alkyl is repeatedly defined as (1-4C) for example, on page 9, line 4, page 9, line 23 and page 10, line 25. In defining W and X, on page 10, the word "alkyl" is again

used, although it is clear from the position of W and X in the molecule that the "alkyl" group must be divalent. However, because the same word was used, it should be clear that it is the intent to define the divalent form in the same manner. Accordingly, it is not appropriate to assert that (1-4C) is new matter.

As to alkenylene, of course, there must be a minimum of two carbons in order to accommodate the  $\pi$  bond.

The remainder of this rejection asserts that only two substituents on  $L^2$ , not  $L^1$ , have been disclosed as able to form a non-aromatic saturated or unsaturated ring, etc. Claim 1 has been amended accordingly and thus this basis for rejection is moot.

Finally, the Office objects to the distance designation of 4.5-24 Å; there is no basis given in this explanation with regard to 35 U.S.C. § 112, First Paragraph, rather the rationale appears to be reflective of a Second Paragraph rejection. Nevertheless, this objection is moot in view of the amendment to the claims.

Based on the foregoing discussion and the amendment to claim 1, it is respectfully submitted that the rejection of this claim under 35 U.S.C. § 112, First Paragraph, may properly be withdrawn.

#### Claims Not Rejected Over the Art

None of claims 2-6, 9, 11-12, 16-37, 39 or 45-84 were rejected over the art. Accordingly, applicants believe that these claims are clearly in a position for allowance once the double-patenting rejections set forth below are addressed.

#### The Art Rejection

Only claim 1 was rejected over the art.

First, claim 1 was rejected as assertedly unpatentable over Japanese application JP 61-291566 in view of CRC Handbook. This basis for rejection is now moot at least because the limitations of claim 11, which was not rejected over this document or this combination, have been added to claim 1.

In addition, applicants point out that there are quite a few differences structurally between the compound focused on by the Office in the Japanese application and the compounds of claim 1. First, the compounds of the Japanese application are benzofurans and the compounds claimed here are benzimidazoles.

Second, the compounds of the present invention comprise a piperazine ring between the benzimidazole and the aryl moiety. The Japanese application compound does not have any piperazine nucleus or any counterpart of it.

Third, the compounds disclosed in the Japanese application, at least according to the English Abstract supplied in applicants' co-pending applications are only useful as intermediates or agrochemicals. There is no suggestion of the disclosed biological properties of the present compounds as inhibitors of p38- $\alpha$  kinase. These properties must be considered in evaluating patentability as set forth in *In re Papesch*, 315 F2d 381, 137 USPQ 43 (CCPA 1963).

Therefore, the combination of the Japanese application with the CRC Handbook is believed not to be germane in view of the structural and functional differences between the compounds claimed and those of the Japanese application set forth above.

Applicants respectfully request withdrawal of this basis for rejection.

Finally, only claim 1 was rejected over the combination of WO 02/070491 in view of the CRC Handbook. The primary reference is simply not citable. The present application is entitled at least to the benefit of its filing date which is 19 May 2000; the priority date, publication date

and application date of WO 02/070491 are all later than the date to which the present application is entitled. There is no possible mechanism whereby the primary document is appropriately cited, now or in the future, with respect to the present claims.

#### Double-Patenting

All claims were provisionally rejected as obviousness-type double-patenting over the pending claims of Serial No. 09/990,187 or certain claims of Serial No. 10/156,997 or Serial No. 09/989,991, all in view of U.S. 6,410,540. As the Office correctly notes, this double-patenting rejection is provisional as no claims have been allowed in any of these cases. Applicants respectfully request that this basis for rejection be held in abeyance until allowable claims are indicated.

#### **CONCLUSION**

All claims, except claim 1, were considered free of the art; claim 1 has been amended to include the limitations of claim 11, a claim that was not rejected. Therefore, it is clear that all claims are free of the art based on this amendment alone. In addition, significant differences between the disclosure of the cited documents and the subject matter of claim 1 have been described above. The formal rejections have also been addressed by amendment or discussion. The only outstanding basis for rejection, therefore, is for obviousness-type double-patenting over pending applications. Applicants respectfully request that the pending claims in the present application be verified as in a position for allowance other than resolution of the provisional double-patenting issue. At that point, applicants would be happy to supply terminal disclaimers as appropriate.

In the unlikely event that the transmittal letter is separated from this document and the Patent Office determines that an extension and/or other relief is required, applicants petition for

any required relief including extensions of time and authorize the Assistant Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to Deposit Account No. 03-1952 referencing docket No. 219002029000.

Respectfully submitted,

Dated: September \_\_, 2003

By: \_\_\_\_\_  
Kate H. Murashige  
Registration No. 29,959

Morrison & Foerster LLP  
3811 Valley Centre Drive,  
Suite 500  
San Diego, California 92130-2332  
Telephone: (858) 720-5112  
Facsimile: (858) 720-5125